



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/587,779

07/28/2006

Gordon Thelwell

5897-000029/US/NP

9918

27572 7590 08/17/2011
HARNESSE, DICKEY & PIERCE, P.L.C.
P.O. BOX 828
BLOOMFIELD HILLS, MI 48303

EXAMINER

RODDEN, JOSHUA E

ART UNIT

PAPER NUMBER

3637

MAIL DATE

DELIVERY MODE

08/17/2011

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/587,779	Applicant(s) THELWELL, GORDON	
	Examiner JOSHUA RODDEN	Art Unit 3637	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 5) ☒ Claim(s) 62-71, 74-83, 86, 87 and 90 is/are pending in the application.
- 5a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 6) ☐ Claim(s) ____ is/are allowed.
- 7) ☒ Claim(s) 62-71, 74-83, 86, 87 and 90 is/are rejected.
- 8) ☐ Claim(s) ____ is/are objected to.
- 9) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 08/01/11 has been entered. Claims 1-61, 72, 73, 84, 85, 88 and 89 have been cancelled. Claims 62-71, 74-83, 86 and 87 have been amended. New Claim 90 has been added.

Specification

2. The amendment to the specification was received 08/01/11. This amendment is acceptable and has been entered.

The disclosure is objected to under 37 CFR 1.74 because of the following:
reference character '607' has been used to denote both "a second inner side member" and "a second connecting side member".

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

Art Unit: 3637

art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 90 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 90 recites "such that during an impacted state the peripheral edges of the outer shell are positioned to engage and make contact with the upright column under a predetermined amount of compression of the inner liner, such that the inner liner provides substantially all of an initial shock absorbing resistance during the impacted state and such that the outer shell, once engaged with and contacting the upright column, augments the shock absorbing resistance provided by the inner liner." However, this claim language appears to constitute new matter as it does not have support within the original disclosure as filed. Additionally, see the "Response to Arguments" section below.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3637

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 90, 62-69, 71, 74-83, 86 and 87 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.K. Patent Application GB 2,321,688 A (Ian) in view of U.S. Patent No. 6,684,572 (Homolka et al.).

Regarding **Claims 90, 62-64, 80-83, 86 and 87**, Ian teaches: **Claim 90** - a column protector device (1-3) for protection of an upright column (9 – wherein it should be understood that the “upright column” is only recited in claim 90 and its dependent claims in terms of the intended use of the “column protector”, and thus the prior art “column protector” of Ian only needs to be capable of performing the intended use, and thus Ian is not required to teach all of the specifics of the “upright column”; Therefore, the “upright column” in this rejection is only detailed in order to detail the functionality of the “column protector” of Ian in regards to the intended use language of the claims, Also See “Response to Arguments Section” Below) of a racking system, (Figure 3); wherein the column (9) has a channel shaped cross section (AA) having a substantially rectangular front portion (BB) consisting of a front member (CC), and first and second side members (DD/FF and EE/FF), (Annotated Figure 2 Below); the column protector device (1-3) being arranged to/capable of clipping onto the upright column (9), (Figure 2

Art Unit: 3637

and Page 4, Lines 10-14); the protector device further comprises a rigid part cylindrical “C” shaped cross section outer shell (3) which defines an elongated slotted opening and a pair of parallel peripheral edges (along (6)) at the slotted opening, and an inner liner (1 and 2) shaped to fit within the outer shell (3), (Figure 2 and Page 3, Lines 3-8 of the specification); wherein the outer shell (3) is configured to/capable of fitting around the upright column (9) so that the outer shell (3) retains to the column (9) without further fixtures, (Figure 2 and Page 4, Lines 10-14); wherein said outer shell (3) is configured to/capable of fitting around said upright column (9) such that the peripheral edges (6) are held apart by the inner liner (1 and 2) and do not contact the upright column (9) when retained in said self attaching manner and when the column protector (1-3) is in a non-impacted state, (Figure 2); the outer shell (3) also surrounds the front member (CC) and partially surrounds the first and second side members (DD/FF and EE/FF), thereby protecting the front member (CC) and parts of the side members (DD/FF and EE/FF), (Annotated Figure 2 Below); the inner liner (1 and 2) being retained between the outer shell (3) and the column (9) in use, (Figure 3); the inner liner (1 and 2) comprises a solid substantially part cylindrical member having a substantially part cylindrical outer surface (the outer corners of (2) are rounded and the inner liner is therefore part cylindrical), the inner liner (1 and 2) also having a substantially “U” shaped channel (the inner surface of portion (1) of the liner (1 and 2) touching the upright column (9)) formed on an opposite side of said inner liner to said substantially part cylindrical outer surface and in which, in use, said channel provides for a flush interface between the inner liner (1 and 2) and the upright column (9), (as seen in Figure 2); the inner liner (1 and 2) being compressible

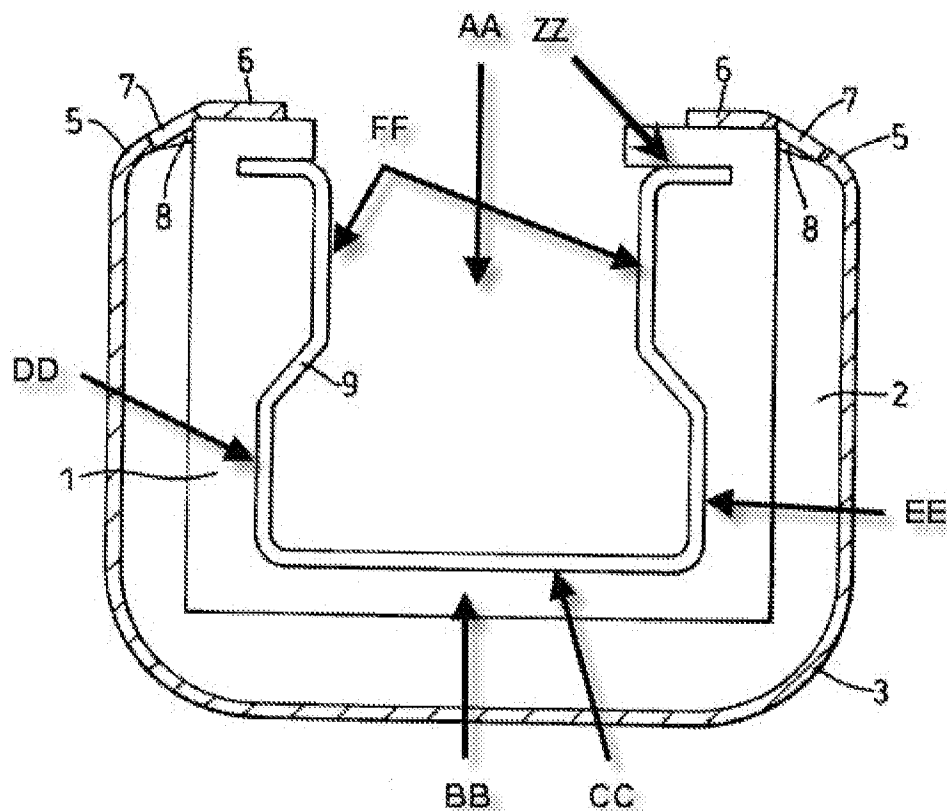
Art Unit: 3637

(See Page 3, Lines 3-8 - wherein it should be understood that the outer shell (3) would be functionally “capable of” augmenting the shock absorbing power of the inner liner (1 and 2) if the outer shell (3) was placed over a different size or shaped column (9) such as a column (9) having portions (ZZ) having extensions which wrap around the end portions (6) of the outer shell (3), Also See “Response to Arguments Section” Below);

Claim 62 – wherein the upright column (9) further includes first and second inner side members (FF), and the outer shell (3) being capable of partially surrounding the first and second inner side members (FF – wherein it should be understood that the outer shell (3) would be functionally “capable of” only partially surrounding the inner side members (FF) if the outer shell (3) was placed over a different size or shaped column (9) such as a column (9) having portions (ZZ) having extensions which wrap around the end portions (6) of the outer shell (3), See “Response to Arguments Section” Below) so that the exposed upright edges (the end edges near item (6) in Annotated Figure 2) of the outer shell (3) lay adjacent to the sides of the column (9) at a position where the column (9) is relatively narrower, (Annotated Figure 2 Below); **Claim 63** – wherein, in use, the column (9) resides partially within a channel formed by the outer shell (3), (Figure 2); **Claim 64** – wherein said outer shell (3) comprises an elongate member having a substantially “C” shaped cross section, (Figure 2); **Claim 80** – wherein said inner liner (1 and 2) is capable of, after receiving an impact, the inner liner (1 and 2) promotes the repositioning of the whole device to an original shape before the impact occurred, (Figure 2 and Page 4, Lines 3-8); **Claim 81** - the outer shell (3) surrounding the front member (CC) and being capable of partially surrounding the first and second

Art Unit: 3637

inner side members (FF – wherein it should be understood that the outer shell (3) would be functionally “capable of” only partially surrounding the inner side members (FF) if the outer shell (3) was placed over a different size or shaped column (9) such as a column (9) having portions (ZZ) which wrap around the end portions (6) of the outer shell (3), See “Response to Arguments Section” Below), and also surrounding the inner liner (1 and 2), which rests between a substantially part cylindrical inner surface of the outer shell (3) and an outer face of the front member (CC), an outer face of the first outer side member (DD) and second outer side member (EE), (Annotated Figure 2 Below); **Claim 82** - the inner liner and outer shell being slideable with respect to each other along a central axis of the outer shell, (Page 1, Lines 24-28); **Claim 83** - the outer liner and an inner liner being bonded together, (Page 2, Lines 1-5); **Claim 86** - the outer shell and the inner liner composed of polycarbonate and foam (Page 2, Line 8 and Page 2, Lines 6-7); both materials having greater ductility, and impact resilience than the shelving which is made from metal (Page 1, Lines 12-14); **Claim 87** - teaches the device being “capable of” fitting around the upright column so that the outer shell (3) retains to the column (9) without further fixtures, (Figure 2 and Page 4, Lines 10-15).



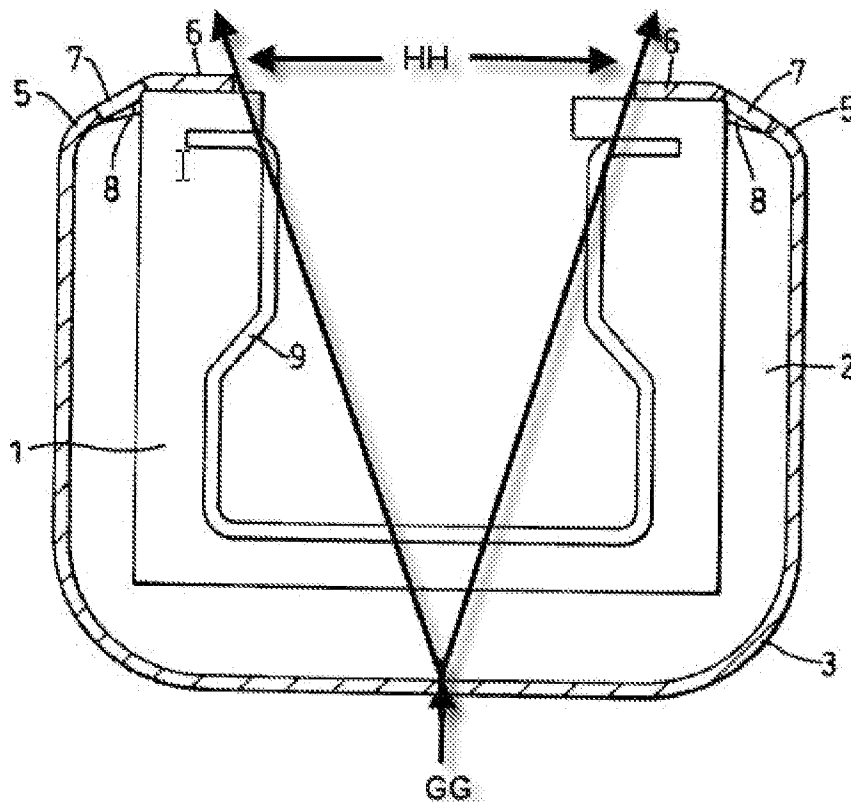
Annotated Figure 2

lan does not teach: wherein the outer shell is substantially cylindrical with a substantially "C" shaped cross section (**Claim 90**). However, **Homolka et al.** teaches: **Claim 61** – an outer shell (8) which is substantially cylindrical with a substantially "C" shaped cross section, (Figures 1-5). Therefore, it would have been obvious to one of ordinary skill in the art to modify the outer shell of the column protector of **lan** to have wherein the outer shell is substantially cylindrical with a substantially "C" shaped cross section (**Claim 61**) as taught by **Homolka et al.** for the purposes of having a shape which has no sharp corners which allows for a safer device which also is more efficient at deflecting impact forces. Additionally, it should be understood that it is extremely well known in the art to make bumpers and Column guards cylindrical in cross section as is

Art Unit: 3637

evidenced by: U.S. Patents No. 1,620,933 (Wilcox), No. 3,372,552 (Liddel), No. 4,113,110 (Mittag), No. 5,482,238 (Kreiter), No. 6,102,611 (Roller) and No. 6,242,070 (Gillispie et al.).

Regarding **Claim 65, *Ian as modified by Homolka et al.*** teaches the column protector as described above (See Rejection of Claim 61 Above), in addition to ***Ian*** teaching the outer shell (3) comprising a tubular substantially cylindrical member (3), (Figure 3); wherein the tube has a pair of substantially parallel opposing edges (the end edges near item (6) in Annotated Figure 2, Version #2 Below) on either side of a gap, (Figure 2). ***Ian as modified by Homolka et al.*** does not teach the cylindrical member extending over an angle in the range of 260 to 280 degrees, but ***Ian*** does teach a range (HH) about a longitudinal centre line (GG) of the outer shell (3) which is very similar to the claimed range, (Annotated Figure 2, Version #2 Below). Therefore, the examiner points to case law *In Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984). The court found that if the only difference between the prior art device and the claims was a recitation of relative dimensions and a device having those claimed dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device (See MPEP 2144). It would have been obvious to one of ordinary skill in the art to modify the prior art device of ***Ian as modified by Homolka et al.*** to have the cylindrical member extending over an angle in the range of 260 to 280 degrees for the purpose of user design as it would not cause the device to perform differently.



Annotated Figure 2, Version #2 (lan)

Regarding **Claims 66-68**, **lan as modified by Homolka et al.** teaches the limitations discussed above, in addition to teaching various dimensional aspects of the claimed invention. **lan as modified by Homolka et al.** does not teach the exact dimensional aspects as recited in claims 66-68. However, the examiner points to case law *In Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984). The court found that if the only difference between the prior art device and the claims was a recitation of relative dimensions and a device having those claimed dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device (See MPEP 2144). Therefore, it would have been obvious to one of ordinary

Art Unit: 3637

skill in the art at the time of the invention to provide the column protector of **lan as modified by Homolka et al.** with a height between 30-120cm, or an external diameter of 10-14cm or an outer wall thickness between 7-9mm since the column protector of **lan as modified by Homolka et al.** would not perform differently then it would before with its previous dimensions.

Regarding to **Claim 69**, **lan as modified by Homolka et al.** teaches the limitations as discussed above, in addition to **lan** teaching a pair of opposing edges (6) spaced apart from one another at a given distance, (Figure 2). **lan as modified by Homolka et al.** does not teach that given distance being between 5cm and 11cm. However, the examiner points to case law *In Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984). The court found that if the only difference between the prior art device and the claims was a recitation of relative dimensions and a device having those claimed dimensions would not perform differently then the prior art device, the claimed device was not patentably distinct from the prior art device (See MPEP 2144). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the distance between the opposing edges of **lan as modified by Homolka et al.** to be between 5cm and 11cm as this would not affect the functioning of the device of **lan as modified by Homolka et al.**

Regarding **Claim 71**, **lan as modified by Homolka et al.** teaches the column protector as described above (See Rejection of Claim 61 Above), in addition to **lan** teaching the outer shell being made from polycarbonate, (Page 2, Line 8). It should also

Art Unit: 3637

be understood that the following materials are all well known in the art as substitutions for polycarbonate: resilient elastomeric polymer based materials; polyethylene; high density polyethylene; polypropylene; polyvinylchloride; polystyrene; plastic; or a mixture of plastics.

Regarding **Claim 74, *lan as modified by Homolka et al.*** teaches the limitations as discussed above, in addition to **lan** teaching the outer surface of the substantially U shaped channel of the inner liner (the inner surface of (1)) being separated a given distance from outer part cylindrical surface (outer surface of liner (2)), (Figure 2). ***lan as modified by Homolka*** does not teach the given dimensions being in the range of 2 to 5cm. However, the examiner points to case law *In Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984). The court found that if the only difference between the prior art device and the claims was a recitation of relative dimensions and a device having those claimed dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device (See MPEP 2144). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the column protector of ***lan as modified by Homolka et al.*** with a distance between the outer part cylindrical surface and the outer surface of the U-shaped channel between 2-5cm since the column protector of ***lan as modified by Homolka et al.*** would operate equally the same with any desired dimensions.

Regarding **Claim 75, *lan as modified by Homolka et al.*** teaches the limitations as discussed above, in addition to **lan** teaching the inner liner being made from a

Art Unit: 3637

compressive composite material, (Figure 2 and Page 2, Lines 1-7). Wherein, it should be understood that the Examiner takes OFFICIAL NOTICE that the following materials are all well known in the art as substitutions for a compressive composite material: polyethylene; polypropylene; polycarbonate; polyvinylchloride; polystyrene; natural rubber foam; synthetic rubber foam; closed cell SBR foam material.

Regarding **Claims 76 and 77, lan as modified by Homolka et al.** teaches the limitations discussed above, in addition to **lan** teaching various dimensional aspects of the claimed invention. **lan as modified by Homolka et al.** does not teach the exact dimensional aspects as recited in claims 76 and 77. However, the examiner points to case law *In Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984). The court found that if the only difference between the prior art device and the claims was a recitation of relative dimensions and a device having those claimed dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device (See MPEP 2144). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the inner liner of **lan as modified by Homolka et al.** with a height between 30-120cm, or an external diameter of 10-14cm since the column protector of **lan as modified by Homolka et al.** would operate the same with any desired dimensions.

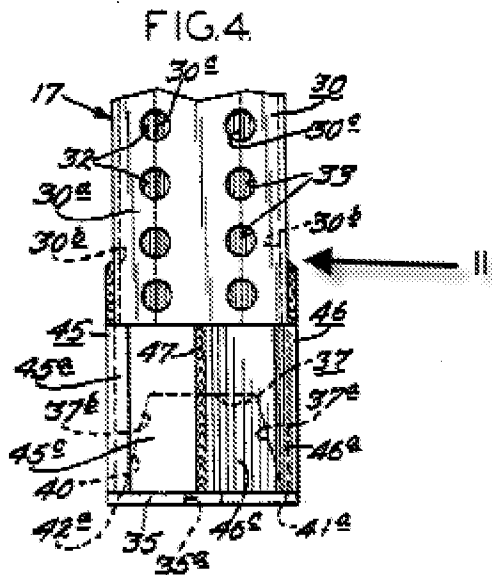
Regarding **Claims 78 and 79, lan as modified by Homolka et al.** teaches the limitations as discussed above, in addition to **lan** teaching the inner liner (1 and 2) being U-shaped and having a given width and depth dimension, (Figures 1(a) and 1(b)). **lan**

Art Unit: 3637

as modified by Homolka et al. does not teach the exact dimensional aspects of the width and depth dimensions as recited in claims 78 and 79. However, the examiner points to case law *In Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984). The court found that if the only difference between the prior art device and the claims was a recitation of relative dimensions and a device having those claimed dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device (See MPEP 2144). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide “U” shaped channel of the inner liner of **lan as modified by Homolka et al.** with width in the range of 7 to 12 cm, or a depth in the range of 2 to 4cm since the column protector of **lan as modified by Homolka et al.** would operate the same with any desired dimensions.

8. **Claim 70 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.K. Patent Application GB 2,321,688 A (lan) in view of U.S. Patent No. 6,684,572 (Homolka et al.), and further in view of U.S. Patent No. 4,088,229 (Jacoby et al.).**

Regarding **Claim 70, lan as modified by Homolka et al.** teaches the limitations discussed above, but does not teach the outer shell having a chamfered edge. However, **Jacoby et al.** teaches a shell of a protector having a chamfered edge (II) between its outer and inner surface, (Annotated Figure 4 Below). Therefore, it would have been obvious to one of ordinary skill in the art to modify **lan as modified by Homolka et al.** to have the outer shell with chamfered edges as taught by **Jacoby et al.** for the purpose of user efficiency and improved protection of the upright column.



Annotated Figure 4

Response to Arguments

9. Applicant's arguments filed 08/01/11 have been fully considered but they are not persuasive.

10. The applicant argues:

"Thus during an impact, by a forklift truck for example, the column protector will first absorb impact forces by compression of the inner liner. This compression will cause the outer shell to move in a direction generally parallel to the sidewalls of the rail. Once the outer shell has moved a sufficient distance to engage with and make contact with the rail (as at 605 and 609 in Figure 6) the outer shell will also begin absorbing some of the impact, through flexure of the outer shell. (See Page 13 of Applicant's Arguments)"

AND

Art Unit: 3637

"In order to more fully distinguish applicant's invention in this regard, new claim 90 is presented for consideration. The dependent claims have been amended to recite dependency on new claim 90, and claim 61 has been cancelled. The Examiner will note, however, that new claim 90 contains essentially the same limitations as claim 61 prior to the February 28, 2011 amendment, except that additional language has been added to more fully explain the two-stage shock absorbing feature discussed above. (See Page 13 of Applicant's Arguments)"

However, the new claim limitations as presented in Claim 90 represent new matter (See 112 new matter rejections above) as they are not fully supported by the specification as originally filed. Specifically, there is no support within the disclosure as originally filed that during an "impacted state", the peripheral edges of the outer liner will contact the column to augment the shock absorbing resistance provided by the inner liner. For example, the disclosure as filed does not make it clear that the inner liner is designed to compress to the point where the outer liner will contact the upright column, and furthermore, it is not clear that the peripheral edges will actually contact the upright column during an "impacted state" as it is well known in the art that cylindrical objects may bow or bend outward upon contact by a force. Additionally, it should be noted that as applicant has not positively claimed the upright, the prior art column protector of Ian as modified by both Homolka et al. and Jacoby et al. is certainly "capable of" meeting the requirements of the new claim language as recited in Claim 90 if the prior art column protector is placed on a specific column allowing it to meet those requirements, wherein it should be understood that a recitation of the intended use, (more specifically, the

Art Unit: 3637

intended effect), of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In this instance, the newly added claim language does not result in a structural difference between the claimed invention (as the applicant is claiming the “column protector” only and not the combination of the “column protector” and the “column”) and the prior art device of Ian as modified by both Homolka et al. and Jacoby et al., and the prior art device of Ian as modified by both Homolka et al. and Jacoby et al. would certainly be capable of meeting the intended use, (more specifically, the intended effect), claim limitations of claim 90 if placed on a given sized and shaped column which would allow it to meet those intended use, (more specifically, the intended effect), limitations.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Josh Rodden whose telephone number is (571) 270-5222. The examiner can normally be reached on M-Th 7am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Darnell Jayne can be reached on (571) 272-7723. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3637

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/MICHAEL SAFAVI/
Primary Examiner, Art Unit 3637

/Joshua Rodden/
Art unit: 3637